

REMARKS

Claims 1 – 7, 12, 14, and 16 - 27 are pending. No new matter has been added. Reexamination and reconsideration of this application are respectfully requested.

In the June 14, 2006 Office Action, the Examiner rejected claims 1 – 7, 12, 14, and 16 – 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2002/0191517 to Honda et al. ("the Honda reference") in view of U.S. Patent No. 5,768,245 to Maeda et al. ("the Maeda reference"). This rejection is respectfully traversed.

The applicant respectfully submits that it is improper to utilize the Honda reference as prior art in a rejection under 35 U.S.C. § 103. Specifically, 35 U.S.C. § 103(c)(1) states that subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. § 102, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The applicant notes that both the present application and the Honda reference are subject to an obligation of assignment to Yamaha Corporation.

The Honda reference qualifies as prior art only under 35 U.S.C. § 102(e) because the Honda reference's filing date predates the filing data of the present application. The Honda reference does not qualify as prior art under 35 U.S.C. § 102(b) because the Honda reference's publication date (i.e., December 19, 2002) is not more than one year prior to the filing date of the present application (i.e., June 26, 2003). Because the Honda reference qualifies as prior art only under 35 U.S.C. §

102(e) and is commonly assigned to Yamaha Corporation, the Honda reference cannot be utilized as prior art in making a 35 U.S.C. 103 rejection. Accordingly, the applicant respectfully requests that the rejection of claims 1 – 7, 12, 14, and 16 – 27 under 35 U.S.C. § 103 be withdrawn.

Assuming, *arguendo*, that the Honda reference is prior art, the applicant submits that claim 1 still distinguishes over the Honda reference. Claim 1 recites:

An optical disc recording apparatus, comprising:  
**an optical pickup which applies a laser beam of substantially constant power to an optical disc;**  
a rotating section which rotates the optical disc at a substantially constant speed;  
a feeding section which moves the optical pickup by a movement distance in a radial direction of the optical disc;  
a detecting section which detects a radial position of the optical pickup with respect to the optical disc; and  
**a movement distance controlling section which changes the movement distance set in the feeding section in accordance with the radial position of the optical pickup detected by the detecting section**

The Examiner states that the Honda reference does not disclose that the optical pickup applies a laser beam of substantially constant power to an optical disc. The applicant agrees with the Examiner and respectfully submits that claim 1 distinguishes over the Honda reference.

The Examiner also states that the Honda reference (in paragraphs [0037] and [0038] and Fig. 6) discloses the above-highlighted **movement distance controlling section** limitation. (*Office Action*, page 3). The applicant respectfully disagrees with the Examiner. The applicant notes that the Honda reference, in paragraph [0008], discloses that the optical disk can include a circumferential-direction position sensor for detecting a circumferential position on the optical disk and a radial-direction positioning sensor for detecting a radial position of the optical pickup on the optical disk. The

Honda reference further discloses that the control circuit performs a control operation for modulating a laser beam emitted from the optical pickup, in accordance with the position detected by the circumferential-direction position sensor and the radial-direction position sensor. (*Honda, paragraph [0008], page 1*).

This is not the same as an optical disc recording apparatus including a **movement distance controlling section which changes the movement distance set in the feeding section in accordance with the radial position of the optical pickup detected by the detecting section**. It is not the same because the Honda reference discloses that the control circuit modulates the laser beam emitted from the optical pickup, based on the position detected by the radial-direction position sensor, but does not disclose that a movement distance is set in a feeding section based on the radial position. Accordingly, applicant respectfully submits that claim 1 further distinguishes over the Honda reference.

The Maeda reference does not make up for the deficiencies of the Honda reference. The Examiner does not state that the Maeda reference discloses the above-highlighted **movement distance controlling section** limitation because the Examiner is utilizing the Maeda reference to disclose that an optical pickup applies a laser beam of substantially constant power to an optical disc. (*Office Action, page 3*). The Maeda reference discloses, in the Summary of the Invention, that the object of the present invention is to record marks on a disk on the same conditions from the inner peripheral portion to the outer peripheral portion. (*Maeda, col. 5, lines 51 – 54*). If the conditions are the same from the inner peripheral portion to the outer peripheral portion, as is disclosed in Maeda, then the Maeda reference cannot disclose an optical disc recording

apparatus including **a movement distance controlling section which changes the movement distance set in the feeding section in accordance with the radial position of the optical pickup detected by the detecting section.** The Maeda reference cannot disclose this highlighted limitation because changing the movement distance set forth in the feeding section, as is recited in claim 1, would be changing the conditions in recording the marks, which goes against the stated objective of the Maeda reference invention. Accordingly, applicant respectfully submits that claim 1 distinguishes over the Honda / Maeda combination.

The applicant also respectfully submits that it is improper to combine the Honda and Maeda references. The Honda reference does not disclose that the laser power is kept at a constant level during recording while the Maeda reference does disclose that the laser power is kept at a constant level during recording. One of skill in the art would not be motivated to combine the Maeda reference with the Honda reference because the Maeda reference is disclosing keeping the laser power constant, which is teaching away from the Honda reference, which does not disclose keeping laser power at a constant level during recording. Teaching away from the art is a *per se* demonstration of the lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Accordingly, one of skill in the art would not consult the Maeda reference to assist in solving the problem addressed in Honda and thus one of skill in the art would not be motivated to combine the Honda reference with the Maeda reference.

In addition, the mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly

or implicitly teaches or suggests the desirability of the modification. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 – 1318 (Fed. Cir. 2000); *In re Fitch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990). Absent such a showing in the prior art, the Examiner has impermissibly used hindsight by using the applicant's teaching as a blueprint to hunt through the prior art for the claimed elements and combine them as claimed. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *Grain Processing Corp. v. American Maize Products*, 840 F.2d 902, 907, 5USPQ2d 1788, 1792 (Fed. Cir. 1988). Neither the Honda or the Maeda references expressly or implicitly teaches the desirability of the modification of the Honda reference by the Maeda reference, i.e., applying laser power at a constant level during recording. Accordingly, the Honda reference and the Maeda reference are not properly combinable.

Independent claims 12 and 14 recite limitations similar to claim 1. Accordingly, applicant respectfully submits that claims 12 and 14 distinguish over the Honda / Maeda combination for reasons similar to those discussed above in regard to claim 1.

Claims 2 – 6 and 16 – 27, depend, indirectly or directly on independent claims 1, 12, and 14. Accordingly, applicants respectfully submits that claims 2 – 6 and 16 – 27 distinguish over the Honda / Maeda combination for the same reasons as those discussed above in regard to claim 1.

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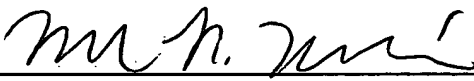
Applicant believes that the claims are in condition for allowance, and a favorable action is respectfully requested. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call either of the undersigned attorneys at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the Examiner believe that such a telephone conference would advance prosecution of the application.

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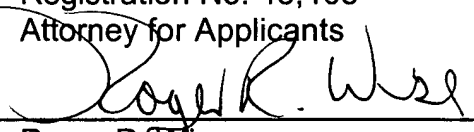
Respectfully submitted,

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